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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/511,968	02/23/2000	Jay S. Walker	96-082-C1	3686

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WALKER DIGITAL  
FIVE HIGH RIDGE PARK  
STAMFORD, CT 06905

EXAMINER

TRAN, HAI V

ART UNIT PAPER NUMBER

2611

DATE MAILED: 06/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/511,968

Applicant(s)

WALKER ET AL.

Examiner

Hai Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-18, 22, 25, 26, 28, 30 and 32-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-21, 23-24, 27, 29, 31, 37-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Objections***

Claims 23-24, 27, 29, and 31 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

In this case, claims 23-24 and 27 depend on the cancelled claim 22; and claims 29 and 31 depend on the cancelled claim 28. The following art rejection is applied to applicant claims as best understood in view of the claim objections above

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 19 recites the limitation "the program" in line 8.

Claim 20 recites the limitation "the program" in line 8.

Claim 38 recites the limitation "the program" in line 6.

There is insufficient antecedent basis for this limitation in the claims. It is unclear how "the program" is related to "an entertainment program" and "the entertainment program". Therefore, claims 19, 20-21 and 38 are rejected.

The following art rejection is applied to applicant claims as best understood in view of the 112 2<sup>nd</sup> paragraph rejection above.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 19 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22 and 23 of U.S. Patent No. 6131086. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitation in claim 19 is a broad recitation of patent claims 22 and 23. It would have been obvious to one of ordinary skill in the art to modify Patent claims 22 and 23 in order to obtain claim 19 of the instant application.

Allowance of claim 19 would result in the unwarranted time-use extension of the monopoly granted for the invention as defined in patent claims 22 and 23.

Claims 20 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 22 and 23 of U.S. Patent No. 6131086. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitation in claim 20 is a broad recitation of patent

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claims 22 and 23. It would have been obvious to one of ordinary skill in the art to modify Patent claims 22 and 23 in order to obtain claim 20 of the instant application.

Allowance of claim 20 would result in the unwarranted time-use extension of the monopoly granted for the invention as defined in patent claims 22 and 23.

Claim 21 corresponds to patent claim 23.

Claim 23 correspond to patent claims 16, 18, 19 and 21.

Claim 24 correspond to patent claims 1, 16, 19, 26, 29, 37, 40, 54.

Claim 27 correspond to Patent claims 1, 16, 19, 25, 26, 29, 37, 40, 54.

Claim 29 correspond to Patent claims 1, 16, 19, 26, 29, 37, 40, 54.

Claim 31 correspond to Patent claims 1, 16, 18, 19, 20, 24, 27, 28.

Claim 37 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 22 of U.S. Patent No. 6131086. Although the conflicting claims are not identical, they are not patentably distinct from each other because limitation in claim 37 is a broad recitation of patent claim 22. It would have been obvious to one of ordinary skill in the art to modify Patent claim 22 in order to obtain claim 37 of the instant application.

Allowance of claim 37 would result in the unwarranted time-use extension of the monopoly granted for the invention as defined in patent claim 22.

Claim 38 corresponds to Patent claim 23.

Claim 39 corresponds to Patent claim 24.

Claim 40 corresponds to Patent claim 25.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 19-21, 23, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (US 6006257).

Claim 19, Slezak does not clearly disclose a terminal coupled to a central controller, to enter product data into the central controller system that allows a viewer to purchase products shown in an entertainment program (read on operator data entry), the terminal comprising means for entering product information relating to a product used in the entertainment program; and means for transmitting to the central controller the product information stored in the local database. However, Slezak discloses wherein the product information includes information identifying how the product information includes information identifying how the product was used in the program (Col. 4, lines 14-20); and a local database storing the product information (secondary information; Fig. 1, el. 524; Fig. 2, el. 38 and Fig. 3, el. 78; Col. 5, lines 10-22; Col. 6, lines 43-45 and Col. 7, lines 34-36);

Because Slezak discloses various programming database that store primary and secondary programming material (product information) in which various subject

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matters can be defined in relationship to the secondary video programming (product information) and assigned number as a record with the respective timing in the primary video programming (the entertainment program). Therefore, one of ordinary skill in the art would have been obvious to modify Slezak to have a terminal coupled to a central controller (video server 520a of Fig. 1) as a data entry terminal so that a data-entry operator could perform data entry product and product related information, and remotely transmitted to the database that reside remotely from the data entry terminal so to provide to user related addition information of a related product advertisement during the TV program scene as disclosed.

Claim 20, Slezak does not clearly disclose "a method for entering product data and transmitting the product data to a central controller which allows a viewer to purchase products shown in an entertainment program, comprising: Entering product information relating to a product used in the entertainment program, wherein the product information includes information identifying how the product was used in the program: Storing the entered product information; and transmitting the stored product information to the central controller." However, Slezak discloses various programming database that store primary and secondary programming material (product information) in which various subject matters can be defined in relationship to the secondary video programming (product information) and assigned number as a record with the respective timing in the primary video programming (the entertainment program). Because of that disclosure, one of ordinary skill in the art

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would have been obvious to modify Slezak to have a terminal coupled to a central controller (video server 520a of Fig. 1) as a data entry terminal so that a data-entry operator could perform data entry product and product related information, and remotely transmitted to the central database that reside remotely from the data entry terminal so to provide to user related information of a related product advertisement during the TV program scene as disclosed.

Claim 21, "wherein the step of transmitting comprises the step of:

Remotely transmitting the stored product information to the central controller".

As discussed in claim 20, the data-entry terminal could be resided at a remote location to the database server. Thus, the entry data must be transmitted to the remote database for storage.

Claim 23, "wherein the means for receiving the request includes means for receiving an identification of the entertainment program in which the product was shown" it is further obvious over Slezak because the search and retrieval (request/query) of a item/record of a relational database depends on an index related to a product in which the user requests.

Claim 37, Slezak discloses a method for allowing entertainment program viewers to purchase products shown in an entertainment program (Col. 33-38).



Slezak does not clearly disclose the step of: "Entering product data about a product used in the entertainment program; Receiving the entered product data; Storing the entered product data in a central database;" However, Slezak discloses "Accessing from the database information about the product used in the entertainment program" (Col. 4, lines 14-19 and Col. 8, lines 32-39). Slezak further discloses various programming database that store primary and secondary programming material (product information) in which various subject matters can be defined in relationship to the secondary video programming (product information) and assigned number as a record with the respective timing in the primary video programming (the entertainment program). Because of that disclosure, one of ordinary skill in the art would have been obvious to modify Slezak to have a terminal coupled to a central controller (video server 520a of Fig. 1) as a data entry terminal so that a data-entry operator could perform data entry product and product related information into the local database and remotely transmitted to the central database that reside remotely from the data entry terminal so Slezak system could be performed as disclosed.

Claim 38, limitation "wherein the step of entering product data includes the substeps of: Entering product information relating to the product shown in the entertainment program, Storing the entered product information in a local database; and remotely transmitting the product information stored in the local database to the central database." Is further met by Slezak as discussed in claim 37 in which

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limitation "wherein the product information includes information identifying how the product was used in the program" is further met by Slezak (Col. 4, lines 14-20);

Claim 39, as to "Receiving from the viewer a request about the product shown in the entertainment program, the request containing a subset of the product information;

Identifying the product information in the database using the subset of the product information; and Sending to the viewer the identified information about the product", it is further obvious over Slezak because the search and retrieval (request/query) of a item/record of a relational database depends on an index related to a product in which the user requests.

Claim 40, wherein the step of accessing includes the substeps of:

Receiving a request from an entertainment program viewer about a product shown in the entertainment program (Col. 4, lines 14-19 and Col. 8, lines 25-38);

As to "Remotely transmitting a query relating to the request; and receiving product information about the product identified in the request", it is further obvious over Slezak because the search and retrieval (request/query) of a item/record of a relational database depends on an index related to a product in which the user requests.

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2. Claims 24, 27, 29 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slezak (US 6006257) in view of Mayer (US 5774534).

Claim 24, Slezak does not clearly disclose wherein the means for receiving the request includes a telephone connection between the viewer and an operator at the operator terminal. However, Slezak shows a means for receiving the request is done through a communication network (see Fig. 1; Col. 6, lines 48-Col. 7, lines 50).

Mayer discloses "the means for receiving the request includes a telephone connection between the viewer and an operator at the operator terminal" (Col. 4, lines 45-Col. 5, lines 22). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Slezak with Mayer so to provide to user an alternative to purchase a product via communication with a live operator.

Claim 27, "the request is received from the interface unit" is further met by telephone interface that receives the request at the operator terminal, as discussed in claim 24

Claim 29, is analyzed with respect to claim 24.

Claim 31, Slezak further disclose wherein the step of receiving the request includes the step of receiving information about the entertainment program information about the product (Col. 4, lines 14-19 and Col. 8, lines 25-38).


***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Tran whose telephone number is 703-308-7372. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

HT:ht  
06/10/2004

  
VIVEK SRIVASTAVA  
PRIMARY EXAMINER